

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/666,778	Applicant(s) GOOSSENS ET AL.	
	Examiner RUSSELL KALLIS	Art Unit 1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): 102(b).
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 15, 20 and 21.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-13, 16-19 and 22-24.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Russell Kallis/
 Primary Examiner, Art Unit 1638
 January 30, 2009

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' amendment and arguments thereof directed toward the definition of the term production in the specification have not been persuasive because the specification defines production as an increased level of detection in the vacuole for example on page 18 paragraph 0043 lines 5-7. Moreover, Applicants' arguments stating that secretion and production are separate processes fails to acknowledge that the specification has embraced coextensive definitions;

from paragraph 0032; An "enhanced secretion" does not necessarily mean that there is a higher production, it can also mean that there exists the same level of production but that the secretion is enhanced.

from paragraph 0043; "In yet another embodiment, the same production of at least one secondary metabolite occurs in the transformed plant but an enhanced secretion of at least one secondary metabolite occurs by the transformed plant. Secondary metabolites can for example be efficiently produced by continuous secretion from the roots of hydroponically grown plants. This process of secretion is also been termed 'rhizosecretion'."

Given the place in prosecution and entrance of the amendment and Applicants' prior notice of appeal it is noted that this issue may necessitate a new grounds of rejection in Examiner's response to the appeal under 112 1st paragraph enablement directed to the issue at hand that the specification does not provide sufficient guidance for those ABC transporters that would only enhance secretion as opposed to those that would enhance production and secretion.

In response to Applicants' assertion over Theodoulou; Applicants' remarks are largely duplicative of those previously filed. Nonetheless, in response to Applicants assert that the references do not teach the exact function of the ABC transporter AtPGP1 and thus the claim limitation is not taught in the prior art. However, the claims are not drawn to any specific or exact activity or function other than the broadly claimed transport of an unspecified secondary metabolite. In addition, the method does not require knowledge of the exact function or metabolite specificity, but rather is permissive for the discovery of that activity during the selection step and is therefore obvious

Further, AtPGP 1 is listed as an embodiment of the invention;

"An MDR-like gene (atpgp 1) has also been identified in *A. thaliana*, which encodes a putative P-glycoprotein homolog. This atpgp 1 gene was found to share significant sequence homology and structural organization with human MDR genes. Other MDR homologues have been found in potato and barley. Genes encoding ABC-transporters of the present invention which may be operably linked with a promoter for expression in a plant species may be derived from a chromosomal gene, cDNA, a synthetic gene, or combinations thereof."; and thus contrary to Applicant's assertions one of ordinary skill would have a reasonable expectation of success.